



1639

Atty. Docket No.: 8039/1122

PATENT

TECH CENTER 1600/2900

DEC 02 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Tomlinson, et al.

Serial No.: 09/888,313

Filed: June 22, 2001

Entitled: "Matrix Screening Method"

Examiner: Tran, My Chau

Group Art Unit: 1639

Conf. No.: 9556

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8a**

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Kathleen M. Williams

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Washington, D.C. 20231

**TRANSMITTAL LETTER**

Enclosed for filing in the above-identified patent application, please find the following documents:

1. Response to Restriction Requirement mailed November 1, 2002;
2. Preliminary Amendment;
3. Return Post Card.

The Commissioner for Patents is hereby authorized to charge any additional fees or credit any overpayment in the total fees to Deposit Account No. 16-0085, Reference No. 839/1122. A duplicate of this transmittal letter is enclosed for this purpose.

Respectfully submitted,

Date: November 12, 2002

Name: Kathleen M. Williams

Registration No.: 34,380

Customer No.: 29933

Palmer & Dodge LLP

111 Huntington Avenue

Boston, MA 02199-7613

Tel: 617-239-0100



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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Restriction Requirement mailed November 1, 2002, Applicants hereby elect **Group I** (claims 1-8, 16-25, 34-36, 45-47, and 55) for prosecution on the merits, with traverse. Applicants submit that this response is being filed within one month of the mailing date of the Restriction Requirement, and therefore believe that no fee is due.

*Lack of two-way distinctiveness*

The requirement for restriction is being traversed for the reasons set forth in detail below, namely, that the Groups as defined by the Examiner do not represent distinct inventions.

The subject matter of the claims in Groups I, VII, XVI, and XVII as defined by the Examiner, are not distinct. The restriction between groups I, VII, XVI, and XVII is made on the basis of group I being drawn to a method for screening a first repertoire against a second repertoire to identify repertoire members which interact, while groups VII, XVI, and XVII are drawn to screening a first repertoire against a second repertoire to identify members which do not interact, screening a peptide repertoire against the same peptide repertoire to identify members

which interact, and screening a polypeptide repertoire against the same polypeptide repertoire to identify members which interact, respectively. The MPEP § 802.01 defines "distinct" as meaning that "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed . . . ." The two "inventions" in Groups I and II as defined by the Examiner, however, are not capable of separate "manufacture," that is, the methods are not capable of separate practice. For example, one of ordinary skill, practicing the "invention" of Group XVI (screening a peptide repertoire against the same peptide repertoire to identify members which interact; Claims 43, 45-47, and 55), would also be practicing the invention of Group I (screening a first repertoire against a second repertoire to identify members which interact). Because the claims of Group XVI cannot be practiced without also practicing the "invention" of Group I, the claims of Groups I and XVI are not distinct as defined by the MPEP § 802.01, and the restriction is improper. Similarly, the claims of Groups VII and XVII cannot be practiced without also practicing the "invention" of Group I. Thus the claims of Groups VII and XVII are not distinct from Group I, and restriction is improper.

In addition, MPEP § 806.05(c) requires that "[i]n order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated" and that "[t]o support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classifications, status, or field of search." In the present case, however, the two-way distinctness requirement has not been met. Although one can practice the claims of Group I without practicing the claims of Group XVI, for example, one cannot practice the claims of Group XVI without practicing at least part of the "invention" of Group I. The same reasoning would apply to the claims of Groups VII and XVII. The claims of Groups I, VII, XVI, and XVII therefore do not satisfy the two-way distinctiveness requirement of MPEP § 806.05(c).

*No undue search burden*

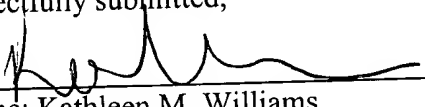
In addition, there would be no additional burden on the Examiner if the claims of Groups VII, XVI, and XVII were rejoined with those of Group I. The MPEP § 803 states, in relevant part, "There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent . . . or distinct as claimed; **and** (B) There must be a serious burden on the examiner if restriction is required . . . ." (emphasis added). The Examiner has stated in the Requirement for Restriction that "the searches required are not co-extensive thus requiring a burdensome search". Applicants maintain, however, that a search on the screening method of Claim 1, for example, will necessarily also include in those search results, the screening methods of Claims 44-47 and 55 (Group XVII). That is, a search for prior art relating to the detection of an interaction between members of a repertoire would certainly include a search for art relating to a screening method wherein the repertoire members are peptides or polypeptides, or where an interaction is not detected at all. There is therefore no additional burden on the Examiner with regards to searching.

**Conclusion**

Applicant submits that all claims are allowable as written and respectfully requests early favorable action by the Examiner. If the Examiner believes that a telephone conversation with Applicants' attorney would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned attorney of record.

Date: November 22, 2002

Respectfully submitted,

  
Name: Kathleen M. Williams  
Registration No.: 34,380  
Customer No.: 29933  
Palmer & Dodge LLP  
111 Huntington Avenue  
Boston, MA 02199-7613  
Tel: 617-239-0100